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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,365	10/26/2001	Steven B. Dawes	SP01-277/9272-8	2877

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MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,365

Applicant(s)

DAWES ET AL.

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-14, 17-21, 23, 28-41, 44, 45, 51-53, 56 and 132-138 is/are pending in the application. ⁴⁸
- 4a) Of the above claim(s) 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 48 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14, 17-21, 23, 28-41, 44, 45, 51-53, 56 and 132-138 is/are rejected. ⁴⁸
- 7) ☐ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) 1 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7-17-2006 has been entered.

Double Patenting

Applicant is advised that should claim 1 be found allowable, claim 31 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 132-138 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner could find no support for the newly claimed limitation of holding the soot preform as required by line 7 of claim 132. In the specification at page 12, lines 17-19, applicant deliberately and clearly sets forth a definition for "hold" and "held". As set forth in MPEP 2111.01 (III): *Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.* Thus, the term "holding" at line 7 is limited to applicant's explicit definition. In other words, the ordinary definition for "hold", "held" and "holding" is not applicable. There is no support for "holding" a soot preform as defined by applicant. This also applies to the holding of line 16.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 7-14, 17-21, 23, 28-41, 44-45, ⁴⁸51-53, 56, and 132-138 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As indicated above, applicant has defined the term “hold” and thus “holding” – and this definition controls the Office’s claim interpretation. Claim 132 requires steps of “holding the soot preform”. But the definition of “hold” (as set forth by applicant on page 12) is directed to an atmosphere, not a preform. Examiner cannot understand how one applies an atmosphere-directed definition to a preform. In other words: it is unclear if the claim 132 means that there “there is substantially no flow of the preform out of the chamber 114 for a finite period of time” or what.

To put it another way: Applicant definition makes the word “hold” an intransitive verb, but in claim 132, the term is used as a transitive verb.

Each independent claim uses at least either “holding” or “pulse”. The terms “hold”, “held” and “pulsing” are defined by applicant. See the specification page 11, lines 17-22 and page 12, lines 17-19. As indicated above, it is Office policy that applicant’s definitions control claim interpretation. Each of Applicant’s definitions are limited to “chamber 114”. Thus it is deemed that the claims are not directed to applicant’s chambers 214, 314 and 414. To examiner, these other chambers are substantially identical to chamber 114. Examiner notes that chambers are substantially the nothingness within a vessel. Thus one might conclude that applicant intended that the “114” constitutes the vessel (page 6, lines 24-25 of the specification supports this) – but the drawings show that the vessels are substantially the same. One of ordinary skill is not reasonably apprised as to what applicant means by “chamber 114” in the definitions.

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Claim 1 states the first and second doping atmospheres are pressurized. Claim 3 calls for a step of pressurizing the atmospheres. There is confusing antecedent basis for these pressurizing steps: it is unclear whether these claim 3 pressurizing steps are in addition to the pressurizing of claim 1, or if they just further limit that pressurizing step, or something else.

Claim 4 requires "increasing the pressure...." There is confusing antecedent basis for "the pressure" since claim 1 refers to two (different) gage pressures. It is unclear whether the two gage pressures must be the same. It is unclear if the pressurizing steps are in addition to the pressurizing of claim 1, or if they further limit the pressurizing step.

All other dependent claims which refer to steps of pressurizing and the like are indefinite as to whether they require further pressurizing or if they merely limit previously mentioned pressurization. There is confusing antecedent basis for "pressurization" in claim 39.

Claim 28 requires that the atmospheres include fluorine-containing compounds – it is unclear if claim 28 requires a compound in addition to the dopants already mentioned in claim 1. This applies to the other similar dependent claims – such as claim 48.

Claim 56: there is confusing antecedent basis for "a soot preform".

Response to Arguments

Applicant's arguments filed 7/17/2006 have been fully considered but are moot in view of the new grounds of rejection.

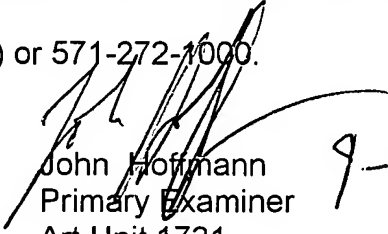
No prior art rejection is made because the prior art does not teach or reasonably suggest a pulse – commensurate with applicant's definition of "pulsing". Nor does the prior art teach or reasonably suggest holding a preform commensurate with applicant's definition of "hold".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John Hoffmann
Primary Examiner
Art Unit 1731

9-22-06

jmh